

REMARKS

This paper is filed in response to the Office Action dated August 13, 2003. As this paper is filed on November 13, 2003, the paper is timely filed.

I. Status of Amendments

Claims 1-28 were pending prior to this amendment. By this amendment, applicants cancel claims 1-28 without prejudice to refile, and add claims 29-54. Thus, claims 29-54 are now pending.

Because applicants previously paid fees for 3 independent and 28 total claims, applicants' amendments do not require a further fee to be paid.

II. Response to Office Action

A General Comments

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.¹ For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the term "invention" may be used to refer to subject matter which is nonobvious; and the term

¹ This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

“invention” may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term “invention” in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘_____’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

B. The August 13 Office Action

Claims 24 and 28 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to meet the enablement requirement. Claims 24 and 28 have been cancelled, thus mooted the rejection.

Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. In particular, it is noted that claims 1 and 9 allegedly fail “to set forth how the interactive symbol is selected for display.” It is also noted that claim 1 “does not state whether or not randomly selecting at least one symbol includes the interactive symbol.” While these rejections are also moot, because claims 1-23 have been cancelled, applicants have the following comments.

Applicants submit that the claim language of former claims 1 and 9 was not indefinite simply because the claims did not limit the fashion in which the interactive symbol was selected for display, or whether the interactive symbol was selected in the “at least one symbol.” For example, the specification states that the interactive symbol may be displayed as one of the randomly generated combination of symbols: “The array symbols 232A-232O are selected and positioned by random upon a player placing a wager and activating the gaming device 200. . . . [t]he symbol 232H operates as an interactive symbol.” Page 10, paras. [0037], [0040]. On the other hand, the “non-array” interactive symbol may “appear in response to various triggering events, such as, for example, the display of a specified symbol, the placement of a predetermined wager, or some other triggering event.” Page 13, para. [0047]. Thus, the fact that the applicants elected to draft the claims broadly in these regards so as to cover more than one disclosed embodiment should not have rendered the claims indefinite.

Claims 1-6, 8 and 25-27 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Jaffe (U.S. Patent No. 6,517,432), claim 7 is rejected under 35 U.S.C. 103 as allegedly unpatentable over Jaffe in view of Vancura (U.S. Patent No. 6,033,307), and claims 24 and 28 are rejected under 35 U.S.C. 103 as allegedly unpatentable over Jaffe in view of applicants’ alleged admissions. Also, claims 9-18 and 20-21 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Baerlocher (U.S. Publ. No. 2002/0016200), claim 19 is rejected under 35 U.S.C. 103 as allegedly being unpatentable over Baerlocher, and claims 22-23 are rejected under 35 U.S.C. 103 as allegedly being unpatentable over Baerlocher in

view of Barrie (GB Publ. No. 2,144,644). While applicants have mooted the rejections by canceling claims 1-28, applicants have the following comments regarding Jaffe, Baerlocher, and Barrie.

Unlike claim 29, for example, Jaffe does not disclose, teach or suggest, for example, receiving a player selection of a selected symbol from the plurality of symbols and transforming the selected symbol into a transformed symbol through perceived interaction between the at least one interactive symbol and the selected symbol. To the contrary, Jaffe states that the allegedly corresponding interactive symbol (“primary streaker symbol 62”) “randomly move[s] around the symbol array formed by the stopped reels 30-34.” Col. 5:15-16. Thus, there is no disclosure, teaching or suggestion in Jaffe that the player be permitted to select which other symbols the allegedly corresponding interactive symbol will interact.

Also unlike claim 29, for example, Baerlocher does not disclose, teach or suggest displaying a plurality of symbols arranged in a plurality of reels, displaying at least one interactive symbol, receiving a player selection of a selected symbol from the plurality of symbols, and transforming the selected symbol into a transformed symbol through perceived interaction between the at least one interactive symbol and the selected symbol. To the extent that it is alleged that that “player symbol” and the “terminating symbol” allegedly correspond to the interactive symbol and the selected symbol of the claimed subject matter, Baerlocher does not appear to disclose, teach or suggest that the player may select one or the other for interaction – those roles are assigned prior to initiation of the path game. Therefore, to the extent that Baerlocher states that “the present invention could include a button or other mechanism for enabling the player to select one or more locations or pick the location for movement of the character” (para. [0074], lines 1-4), this does not correspond to the player selection recited in the newly presented claims, which recites that a player selects a symbol from a plurality of symbols to be transformed through perceived interaction with at least one interactive symbol.

Further unlike claim 29, for example, Barrie does not disclose, teach or suggest determining a payout associated with a set of symbols including the transformed symbol and at least one other symbol of the plurality of symbols. To the extent that it may be alleged that each “door” corresponds to the selected symbol, Barrie states that “[t]he selected door is randomly assigned to a lose class or a win class.” Page 2:35-37. Thus, each door is

individually responsible for a win or a loss, not a configuration of the door and other doors displayed.

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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Date: November 13, 2003

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